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09/913,850	12/14/2001	Kevin C. Hazen	032905-010	5481

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EXAMINER

ZEMAN, ROBERT A

ART UNIT PAPER NUMBER

1645

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicati n N .	Applicant(s)	
	09/913,850	HAZEN ET AL.	
	Examiner	Art Unit	
	Robert A. Zeman	1645	

**-- The MAILING DATE of this communication appears n the cover sheet with the c rrespondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 14-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's election with traverse of Group II in the paper filed on 11-4-2003 is acknowledged. The traversal is on the following ground(s):

- There would not be a serious burden to search the entire application.
- The Office has failed to set forth why a restriction is required.
- Group II and III have unity of invention since Group III is drawn to methods utilizing the antibodies of Group II.
- Group VIII and IX have unity of invention since Group IX is drawn to methods utilizing the antibodies of Group VIII.
- There is no explanation why the instant restriction requirement differs from the lack of unity done in International PCT Application.
- Groups I-VI, Groups VII-XII and XIII-XVI should be rejoined based on the commonality of their sequences or cell lines since there search would be coextensive

Applicant's traversal is not found persuasive because:

- Contrary to Applicant's assertion, the searches the multitude of peptides, antibodies, and methods encompassed by the various groups would constitute a serious burden since said searches would not be coextensive in scope.
- Contrary to Applicant's assertion, the reason why a restriction was required was set forth on page 3 of the restriction requirement.
- With regard to Applicant's argument that the instant restriction requirement cannot deviate from a lack of unity done in the International PCT application,

Applicant is reminded that each application is examined based on its own merits and that said examination is not governed by the prosecutorial history of other applications.

- Contrary to Applicant's assertion that Groups I-VI, Groups VII-XII and XIII-XVI should be rejoined based on the commonality of their sequences or cell lines since there search would be coextensive, the multitude of peptides, antibodies, and methods encompassed by the various groups would constitute a serious burden since said searches would not be coextensive in scope.

The requirement is still deemed proper and is therefore made FINAL.

It should be noted that the examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined

claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined.

See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claims 1-48 are pending. Claims 1-7 and 14-48 have been withdrawn from consideration. Claims 8-13 are currently under examination.

### ***Claim Objections***

Claims 8-12 are objected to because of the following informalities:

Claim **8** is objected to as being dependent on a non-elected claim.

Claims 9-12 are objected to for starting with an improper article. Independent claims should start with the article "A" or "An, while dependent claims should start with the article "The".

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Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-11 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that the antibody 6C5 and the cell line F6-6C5-H4. The deposit of biological organisms is considered by the Examiner to be necessary for the enablement of the current invention (see 37 CFR 1.808(a)). The examiner acknowledges that Applicant has stated on page 13 of the specification that the cell line F6-6C5-H4 has been deposited with ATCC in partial compliance with this requirement. However, said deposits are not in full compliance with 37 CFR 1.803-1.809.

If the deposit is made under terms of the Budapest Treaty, then an affidavit or declaration by Applicants or person(s) associated with the patent owner (assignee) who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty *and* that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements. See 37 CFR 1.808.

If a deposit is not made under the terms of the Budapest Treaty, then an affidavit, or declaration by Applicants or person(s) associated with the patent owner (assignee) who is in a

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position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the following criteria have been met:

- 1) during the pendency of the application, access to the deposit will be afforded to one determined by the Commissioner to be entitled thereto;
- 2) all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent; and
- 3) the deposits will be maintained for a term of at least thirty (30) years from the date of the deposit or for the enforceable life of the patent or for a period of at least five (5) years after the most recent request for the furnishing of a sample of the deposited material, whichever is longest; and
- 4) a viability statement in accordance with the provisions of 37 CFR 1.807; and
- 5) the deposit will be replaced should it become necessary due to inviability,

contamination or loss of capability to function in the manner described in the specification.

In addition, the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.803 – 1.809 for additional explanation of these requirements.

### ***35 U.S.C. First Paragraph, Written Description***

Claims 8-9 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are drawn to a vast genus of antibodies, which bind to a peptide encompassed by claim 1. To fulfill the written description requirements set forth under 35 USC § 112, first paragraph, the specification must describe at least a substantial number of the members of the claimed genus, or alternatively describe a representative member of the claimed genus, which shares a particularly defining feature common to at least a substantial number of

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the members of the claimed genus, which would enable the skilled artisan to immediately recognize and distinguish its members from others, so as to reasonably convey to the skilled artisan that Applicant has possession<sup>of</sup> the claimed invention. To adequately describe the genus of antibodies, Applicant must adequately describe the peptides encompassed by claim 1 to which the antibodies bind.

However, the specification does not disclose distinguishing and identifying features of a representative number of members of the genus of peptides to which the claims are drawn, such as a correlation between the structure of the peptide and its recited function, so that the skilled artisan could immediately envision, or recognize at least a substantial number of members of the claimed genus of antibodies. Moreover, the specification fails to disclose which amino acid residues are essential to the function of the peptide, or which amino acids might be replaced or deleted so that the resultant peptide retains the activity of its parent, or by which other amino acids the essential amino acids might be replaced so that the resultant peptide retains the activity of its parent. Therefore, the specification fails to adequately describe at least a substantial number of members of the genus of peptides to which the claims refer; and accordingly the specification fails to adequately describe at least a substantial number of members of the claimed genus of antibodies.

MPEP § 2163.02 states, “[a]n objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed’ ”. The courts have decided:

The purpose of the “written description” requirement is broader than to merely explain how to “make and use”; the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the “written description” inquiry, *whatever is now claimed*.



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See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Federal Circuit, 1991). Furthermore, the written description provision of 35 USC § 112 is severable from its enablement provision; and adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

*The Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, paragraph 1, "Written Description" Requirement* (66 FR 1099-1111, January 5, 2001) state, "[p]ossession may be shown in a variety of ways including description of an actual reduction to practice, or by showing the invention was 'ready for patenting' such as by disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention" (*Id.* at 1104). Moreover, because the claims encompass a genus of variant species, an adequate written description of the claimed invention must include sufficient description of at least a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics sufficient to show that Applicant was in possession of the claimed genus. However, factual evidence of an actual reduction to practice has not been disclosed by Applicant in the specification; nor has Applicant shown the invention was "ready for patenting" by disclosure of drawings or structural chemical formulas that show that the invention was complete; nor has Applicant described distinguishing identifying characteristics sufficient to show that Applicant were in possession of the claimed invention at the time the application was filed.

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The *Guidelines* further state, “[f]or inventions in an unpredictable art, adequate written description of a genus which embraces widely variant species *cannot* be achieved by disclosing only one species within the genus” (Id. at 1106); accordingly, it follows that an adequate written description of a genus cannot be achieved in the absence of a disclosure of at least one species within the genus. As evidenced by the teachings of Skolnick et al., the art is unpredictable. Skolnick et al. (*Trends in Biotechnology* 18: 34-39, 2000) discloses the skilled artisan is well aware that assigning functional activities for any particular protein or protein family based upon sequence homology is inaccurate, in part because of the multifunctional nature of proteins (see, e.g., the abstract; and page 34, *Sequence-based approaches to function prediction*). Even in situations where there is some confidence of a similar overall structure between two proteins, only experimental research can confirm the artisan's best guess as to the function of the structurally related protein (see, in particular, the abstract and Box 2). Thus, one skilled in the art would not accept the assertion, which is based only upon an observed similarity in amino acid sequence, that a variant of the polypeptide of SEQ ID NO: 2 is capable of promoting, augmenting, or otherwise enhancing cell differentiation, or delaying, repressing, or otherwise inhibiting cell proliferation or tumorigenesis. Therefore, because the art is unpredictable, in accordance with the Guidelines, the description of the embodiment is not deemed representative of the genus of peptides to which the claims refer.

***35 U.S.C. First Paragraph, Enablement Rejection***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-9 and 12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for antibodies produced by the hybridoma cell lines F6-6C5-H4, F6-5F8-E10 and F6-5D8-A12 (6C5, SF8 and 5D8 respectively), does not reasonably provide enablement for the myriads of other antibody species claimed. The specification is enabling only for claims limited to antibodies produced by the hybridoma cell lines F6-6C5-H4, F6-5F8-E10 and F6-5D8-A12 because the specification does not reasonably provide enablement for antibodies with specificity for peptides with the general formula  $G-X_1-X_2-R$ . The specification does not enable any person skilled in the art to which it pertains or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The aforementioned claims are drawn <sup>to</sup><sub>A</sub> antibodies with specificity for peptides with the general formula  $G-X_1-X_2-R$ . Neither said peptides or any antibodies that bind them have any claimed biochemical, immunological or physiological function.

Protein chemistry is probably one of the most unpredictable areas of biotechnology. Consequently, the effects of sequence dissimilarities upon protein structure and function cannot be predicted. Bowie et al (Science, 1990, 257:1306-1310) teach that an amino acid sequence encodes a message that determines the shape and function of a protein and that it is the ability of these proteins to fold into unique three-dimensional structures that allows them to function and carry out the instructions of the genome and further teaches that the problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. (column 1, page 1306). Bowie et al further teach that while it is known that many amino acid substitutions are possible in any given protein, the position within the protein's

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sequence where such amino acid substitutions can be made with a reasonable expectation of maintaining function are limited. Certain positions in the sequence are critical to the three dimensional structure/function relationship and these regions can tolerate only conservative substitutions or no substitutions (column 2, page 1306). The sensitivity of proteins to alterations of even a single amino acid in a sequence are exemplified by Burgess et al (J. of Cell Bio. 111:2129-2138, 1990) who teach that replacement of a single lysine residue at position 118 of acidic fibroblast growth factor by glutamic acid led to the substantial loss of heparin binding, receptor binding and biological activity of the protein and by Lazar et al. (Molecular and Cellular Biology, 1988, 8:1247-1252) who teach that in transforming growth factor alpha, replacement of aspartic acid at position 47 with alanine or asparagine did not affect biological activity while replacement with serine or glutamic acid sharply reduced the biological activity of the mitogen. These references demonstrate that even a single amino acid substitution will often dramatically affect the biological activity and characteristics of a protein (antibody). Clearly, the biological functions (other than peptide binding) of antibodies with specificity for peptides with the general formula  $G-X_1-X_2-R$  cannot be predicted. Consequently, given the teachings of Bowie et al., Lazar et al. and Burgess et al. the function of the claimed antibodies could not be predicted based on sequence. Further, even if a given antibody possesses all the structural limitations of the claimed invention, neither the specification nor any art of record teaches what that antibody does, nor does it teach a relationship to any specific disease or establish any involvement of the said antibody in the etiology of any specific disease or teach which fragments might be active or which derivatives would function as claimed in a pharmaceutical composition. Clearly, it could not be predicted that an antibody will function in a given manner. Reasonable correlation must exist between the scope of the claims and scope of enablement set forth, and it cannot be predicted from the disclosure how to use antibodies with specificity for peptides with the general formula  $G-X_1-X_2-R$ . In view of the above, one of skill in the art would be forced into undue experimentation to practice the claimed invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 31-34 of copending Application No. 09/913,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim sets encompass the same antibodies (5F8, 5D8 and 6C5) and the hybridomas producing them.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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Claims 8-9 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by Ruben et al. (WO 98/39448).

Ruben et al. disclose peptides that meet the general formula  $G-X_1-X_2-R$  (see SEQ ID NO:608 for example). Ruben et al. further <sup>disclose</sup> antibodies against said peptides (see pages 183-184). Consequently, Ruben et al. discloses all the limitations of the rejected claims.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (571) 272-0866. The examiner can normally be reached on Monday- Thursday, 7am -5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert A. Zeman  
February 5, 2004

*L. F. Smith*  
**LYNETTE R. F. SMITH**  
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